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EXAMINER
HALEY, J

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ART UNIT	PAPER NUMBER
1201	8

DATE MAILED: 09/06/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5-10-94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), ~~_____~~ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 29-36 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-28 have been cancelled.
3. ☒ Claims 31-32 are allowed.
4. ☒ Claims 29-30, 33-36 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 9-89)

Claims 29-36 are pending.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 29-30, 33-34 are rejected under 35 U.S.C. § 103 as being unpatentable over Lauerer, et al., US 3,278,448. Lauerer et al. teach compounds useful as ultraviolet filters which are embraced by the genus claimed in claims 29 and 30. Note that when the formula at line 45 of column 1 of Lauerer defines Ar as dihydroxy-halophenyl, R^1 is cyano, R^3 is hydrogen and R^2 is COX (X is primary or secondary amine), the compounds fall within the claimed genus. One having

ordinary skill in the art would have been motivated from this teaching of useful compounds to select among the substituents taught as equivalents to arrive at compounds useful for the reference utility. Absent a showing of unexpected properties, the compounds are obvious from Lauerer, et al. Note that the composition claims are also included in this rejection since the compounds in combination with a carrier are considered to be compositions.

Applicant's arguments have been carefully considered, however the same are not persuasive. The fixed position of the X group is not sufficient to overcome the obviousness of the claimed compounds since Lauerer still discloses isomers of such as well as having generic disclosure to such. Applicant's arguments that the species disclosed by Lauerer are so far removed from the claimed compounds herein are to no avail since Lauerer is far more instructive than the species disclosed therein. First, it is pointed out that while Lauerer may only disclose a few specific amide compounds, it is clear that his invention is directed to acids, esters and amides. Further, one having ordinary skill in the art in possession of an ester or acid would readily be able to convert to the amide, especially given Lauerer's teaching of equivalency of such. Applicant has not shown that any of the claimed compounds possess unexpected properties from the compounds of Lauerer. Absent such, the compounds are obvious.

Claims 35-36 are rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. Each of the newly-presented claims is directed to a compound, yet these claims are dependent from a composition. Thus, the term "the compound" used in each claim finds no antecedent support, and also suffers under 35 USC 112, second paragraph as failing to distinctly claim the invention, i.e. as being indefinite.

Claims 31-32 are allowed.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Examiner Haley at telephone number (703) 308-4548. The examiner may normally be reached Monday through Friday from 8:30 am until 6:00 pm.

jh
August 30, 1994

Robert W. Ramsuer
Art Unit 1201